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09/213,131	12/15/1998	ERIC C. ANDERSON	1104-069	7384
74548 7590 04/16/2010 FlashPoint Technology and Withrow & Terranova 100 Regency Forest Drive Suite 160 Cary, NC 27518				
			EXAMINER AGGARWAL, YOGESH K	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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1. Applicant argues with regards to claims 7 and 15 that “alternative elements are positively recited in the specification, they may be explicitly excluded in the claims”, a scanner is taught by the specification. The Examiner respectfully disagrees. The specification at page 7 lines 9-12 discusses figure 2 where a photographer has focused imaging device 114 on object 112 and using a capture button or... instructed camera 110 to capture an image of an object 112. Clearly the image capturing device is a camera and not a scanner. Therefore there is no positive recitation anywhere in the specification that the device is not a scanner and therefore the question of the device being explicitly excluded in the claims does not even arise. The whole specification only recites that this is a camera.
2. Applicant argues that throughout the originally filed application, such as Figures 2-10 and the accompanying description, discussion is made regarding a digital camera 110, the various components of the digital camera 110, and the operation of the digital camera 110, which both the Examiner and the BPAI has equated with a scanner. Thus, according to the Patent Office, a digital camera is the same thing as a scanner. The Applicants submit that as the Specification clearly recites a digital camera, which the Patent Office has equated with a scanner, then the Applicants are entitled to explicitly exclude a scanner in the claims. The Examiner respectfully disagrees. Since the Examiner and the BPAI has equated the digital camera and a scanner and the applicant is claiming that the imaging capturing device is not a scanner, it cannot be a camera too since they are the same. This is what makes the claims inconsistent with respect to the specification, since the specification describes the image capturing device to be only a camera and the claims recite it cannot be a scanner or a camera (since they are same). This is a clear

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inconsistency. The applicant's simply cannot exclude one device from the claims when they are both deemed to be the same by the examiner and the BPAI. The prior art teaches a scanner which the BPAI has clearly said that it falls within the broad definition of a digital camera. In view of this, the Examiner would still maintain the 112 first paragraph rejection.

3. Applicant argues that they are entitled to disclaim something that may arguably fall within the broadest reasonable interpretation of the claims. By reciting that the image capture device is not a scanner, the Applicant is merely pointing out that the claim does not cover a scanner in order to avoid an overly broad interpretation of the pending claims when viewed in light of the Specification. Thus, the Applicant submits that the claims comply with 35 U.S.C. § 112, first paragraph. Nonetheless, according to Chapter 2163 of the M.P.E.P., "While there is no in haec verba requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." The Examiner respectfully disagrees. Clearly, the word scanner is not explicitly recited in the specification. The question arises for the implicit disclosure. This has to be considered in the context of the intent of the inventor. No where does the specification recite that the image capturing device is any thing other a camera. Therefore the applicant clearly did not wanted anything other than a camera. The evidence of the applicant's invention being implemented anywhere other than a camera is found only in the prior art (Parulski) since it teaches the same invention as the applicant, only in a scanner. There is nothing wrong with claiming a negative limitation as long as the specification teaches one skilled in the art something explicitly or implicitly. If the prior art taught any other image capturing device (e.g. a facsimile) teaching the same invention

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as applicant's, then simply reciting in the claims that the image capturing device is not a facsimile in order to overcome the prior art does not make the claims compliant with the specification since the specification only talks about a digital camera and the broad definition of it encompasses all these devices. This is also consistent with the decision of Court of Appeals for the Federal Circuit (that applicant has pointed out) has recently held, "the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented". Clearly, nothing in the specification show that the applicant's wanted to exclude a scanner. Rather the prior art is the only place which actually contradicts this idea since the similar invention has been implemented in the prior art in a different device, namely a scanner. There is no intent on the part of the applicant in their specification which shows to one skilled in the art that the invention could have been implemented anywhere other than a camera. Therefore the rejection would be sustained.